CUSTOMER NO. 30430

PATENT APPLICATION
Docket No. 01-OT-080

REMARKS

In the Advisory Action dated January 25, 2006, the Examiner refused entry of Applicant's Amendment after final (dated January 13, 2006) on the ground that the presented claim amendments added a new limitation which would raise a new issue requiring further search.

Applicant respectfully submits that the Examiner has failed to properly consider Applicant's request to withdraw the FINAL Office Action dated December 14, 2006. If that request were granted, the amendments to the claims presented by the Applicant in the Response of January 13, 2006, would be permissible.

Applicant accordingly requests reconsideration and reiterates a request, pursuant to MPEP 706.07(d), that the FINAL Office Action dated December 14, 2006, be withdrawn as being **premature**. Additionally, Applicant requests that the Examiner enter and consider the Amendment dated January 13, 2006. In support of these requests, Applicant submits the following arguments for the Examiner's consideration.

1. **No clear issue has been developed between the Examiner and Applicant**

MPEP 706.07 discusses when a second office action on the merits should be made final. In accordance with 37 CFR 1.113(a), a second office action on the merits "may be made final." The indication from Rule 113(a) therefore is that making a second office action final is a permissive action by the Examiner, NOT A REQUIREMENT. In fact, MPEP 706.07 clearly states that "Before final rejection is in order a clear issue should be developed between the examiner and the applicant." In the present situation, Applicant respectfully submits that no

clear issue had been developed between the Examiner and Applicant as of the December 14, 2005, Office Action.

MPEP 706.07 states that in a situation where there is a "switching ... from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, [this tends] to defeat attaining the goal of reaching a clearly defined issue...." Applicant respectfully submits that such a switching of references by the Examiner on exactly identical claimed subject matter has occurred in the present application. In view of this fact, no clear issue has been developed between the Examiner and the Applicant, and thus a making of the December 14, 2005, Office Action FINAL is not permitted.

In support of the foregoing, Applicant notes the Examiner's statement, taken from the December 14, 2005, Office Action, that "Claims 1-46 are unchanged and remaining pending." This statement by the Examiner is correct in that it is clear that Applicant, in responding to the first Office Action of August 16, 2005, did not make any amendments or changes to the independent claims of the application. Rather, Applicant argued against the Section 102/103 rejections which the Examiner based primarily on the Reddy reference. These arguments appear to have been persuasive as the rejections based on Reddy were withdrawn in the December 14, 2005, Office Action.

However, in the December 14, 2005, Office Action the Examiner asserted, **for the first time**, Section 102/103 rejections based primarily on the Lu and Cole references. The Examiner's actions in citing the Lu and Cole references, and withdrawing the rejections based on the Reddy reference, clearly constitute a "switching ... from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter,

[which would] tend to defeat attaining the goal of reaching a clearly defined issue...." Pursuant to MPEP 706.07, the making of the December 14, 2005, Office Action final in such a situation is not permitted.

Applicant further notes, from MPEP 706.07, an instruction that the Applicant should "not be prematurely cut off in the prosecution of his or her application." The making of the December 14, 2005, Office Action final effectuated just such a premature cut off by denying the Applicant an opportunity to address the newly presented Section 102/103 rejections based on the previously un-asserted Lu and Cole references. Current Office practice "does not sanction hasty and ill considered final rejections." See, MPEP 706.07. In this case, the actions of the Examiner have denied Applicant "a full and fair hearing" on the merits of the asserted rejections. Applicant is entitled, in this situation where no "clear issue [has been] developed between the examiner and applicant," to entry of the Amendment dated January 13, 2006.

Because the Examiner has switched "from one set of references to another ... in rejecting in successive actions claims of substantially the same subject matter," no "clear issue [has been] developed between the examiner and the applicant." The making of the December 14, 2005, Office Action final is thus per se improper. Applicant accordingly requests that the finality of the December 14, 2005, Office Action be withdrawn.

2. The Examiner is precluded from making the Office Action final

MPEP 706.07(a) states that a second office action on the merits should be made final EXCEPT "where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information

disclosure statement...." In the present situation, there is no justification for making the second action on the merits final.

First, Applicant reiterates that, in responding to the first Office Action of August 16, 2005, Applicant did not make any amendments or changes to the independent claims of the application. Rather, Applicant argued against the Section 102/103 rejections which the Examiner based on the Reddy reference. These arguments in favor of the claims were persuasive as the Examiner withdrew all rejections based on Reddy when issuing the December 14, 2005, Office Action. The Examiner did, however, reject the claims in the December 14, 2005, Office Action under Sections 102/103 by asserting two NEWLY ASSERTED prior art references (Lu and Cole). Since Applicant did not amend the independent claims, the rejection based on the Lu and Cole references, which constitutes "a new ground of rejection," was NOT necessitated by Applicant's amendment to the claims, and thus the making of the office action final is improper.

Second, Applicant points out that the Lu and Cole references relied upon by the Examiner in the December 14, 2005, Office Action were NOT cited to the Office by the Applicant in an information disclosure statement filed during the period set forth in 37 FR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Rather, as clearly indicated by the prosecution history, the Examiner had access to both the Lu and Cole references, from the Examiner's own search of the prior art, when issuing the first Office Action on the merits (see, FORM 892, attached to the Office Action dated August 16, 2005). It is thus clear that the Examiner could have asserted both the Lu and Cole references much earlier in the prosecution history.[1] There is

1 Applicant further notes that it is unfair to the Applicant, and further fails to serve the purpose of developing a clear issue between the examiner and the applicant (MPEP 706.07), for the Examiner to wait until Applicant has

no basis then for making the office action final due to Applicant's filing of an information disclosure statement.

Because "the examiner [has introduced] a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement" (MPEP 706.07(a)), the making of the December 14, 2005, Office Action final is per se improper. MPEP 706.07(a) clearly instructs the Examiner that "a second ... action on the merits ... **will not be made final** if it includes a rejection, on newly cited art ... of any claim not amended by applicant" (emphasis added). Applicant accordingly requests that the finality of the December 14, 2005, Office Action be withdrawn.

3. Conclusion

In view of the foregoing, Applicant respectfully requests, pursuant to MPEP 706.07(d), that the Examiner reconsider the finality of the December 14, 2005, Office Action. Applicant further submits that the final rejection is premature and requests that it be withdrawn. Applicant still further requests that the Examiner enter Applicant's Amendment dated January 13, 2006.

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distinguished the art reference cited in the first office action before asserting other, allegedly more pertinent, art references against un-amended claims and then making the action final. This action by the Examiner effectively precludes the Applicant from substantively addressing the new rejection and denies Applicant "a full and fair hearing on the merits" (MPEP 706.07).

CUSTOMER NO. 30430

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Docket No. 01-OT-080

Applicant submits that the application is now in condition for favorable action and allowance.

Respectfully submitted,
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